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Michel Bisson

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10/04/2006

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EXAMINER

PHAM, HUNG Q

ART UNIT

PAPER NUMBER

2168

DATE MAILED: 10/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/021,855

Applicant(s)

BISSON ET AL.

Examiner

HUNG Q. PHAM

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 24-29, 63, 64 and 68-73 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 24-29, 63, 64 and 68-73 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Response to Arguments*

#### Claim Rejections - 35 USC § 112

Applicants' arguments with respect to the rejection of claims 24, 25, 63, 64, 68 and 69 have been fully considered but they are not persuasive.

As indicated in the previous action, the claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. By definition, JAVABEAN and ENTERPRISE JAVABEANS are JAVA component models for enterprise application (Monson-Haefel, Enterprise JavaBeans). In the current application, JAVABEAN and ENTERPRISE JAVABEANS are used as JAVA objects and, accordingly, the identification/description is indefinite.

#### Claim Rejections - 35 USC § 101

Applicants' arguments with respect to the rejection of claims 24, 63 and 76 under 35 U.S.C. § 101 have been fully considered but they are not persuasive.

As argued by applicants at page 8:

*With all due respect, the Examiner's rejection is traversed. The objected to claims are directed to software and software claims are plainly statutory subject matter under current case law. Also claims 33 and 68 are canceled.*

Examiner respectfully disagrees.

Claims 24, 63 and 68 do not produce a useful and tangible result as set forth in MPEP 2106 (IV)(B)(2)(b) and 2106(IV)(B)(2)(b)(ii), e.g., a created ENTERPRISE JAVABEAN or an

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obtained security realm are not useful and tangible results. Therefore, claims 24 and 63 are non-statutory.

Regarding claim 68, instead of defining a system by identifying the physical structure of the system in term of its hardware or hardware and software combination, the system of claim 76 directs to software *per se*. Therefore, claim 76 is non-statutory.

Claim Rejections - 35 USC § 103

As argued by applicants at page 9:

*Applicants respectfully submit that the newly added limitations in the independent claims distinguish over Singer and Timbol.*

*In addition, applicants note that Singer only discloses the use of one database whereas all the claims require the presence of two databases.*

Examiner respectfully disagrees.

- Applicants' arguments with respect to the newly added feature have been considered but are moot in view of the new ground(s) of rejection.
- Applicants' arguments with respect to the Singer have been fully considered but they are not persuasive. Singer discloses the use of two databases, one is the Permit Database 18 (FIG. 1) and another one is disclosed at Col. 8, Lines 30-41. The second one is controlled by e-payment system 20 of FIG. 1 (Singer, Col. 8, Lines 37-43).

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**Claim Rejections - 35 USC § 112**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 24, 25, 63, 64, 68 and 69 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Claims 24, 25, 63, 64, 68 and 69 contain the trademark/trade name JAVABEAN and ENTERPRISE JAVABEAN. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe computer program for developing and executing other computer programs on computers and, accordingly, the identification/description is indefinite.

As in claims 24, 63 and 68, the claimed limitation, *the user or application of the naming convention of the data in the database*, references to other items in the claims. It is unclear what item is being referenced.

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**Claim Rejections - 35 USC § 101**

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claims 24-29, 63, 64 and 68-73 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

As set forth in MPEP 2106 (IV)(B)(2)(b):

A claim that requires one or more acts to be performed defines a process. However, not all processes are statutory under 35 U.S.C. 101. *Schrader*, 22 F.3d at 296, 30 USPQ2d at 1460. To be statutory, a claimed computer-related process must either: (A) result in a physical transformation outside the computer for which a practical application in the technological arts is either disclosed in the specification or would have been known to a skilled artisan (discussed in i) below), or (B) be limited to a practical application within the technological arts (discussed in ii) below). See *Diamond v. Diehr*, 450 U.S. at 183-84, 209 USPQ at 6 (quoting *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1877)) ("A [statutory] process is a mode of treatment of certain materials to produce a given result. It is an act, or a series of acts, performed upon the subject-matter to be transformed and reduced to a different state or thing.... The process requires that certain things should be done with certain substances, and in a certain order; but the tools to be used in doing this may be of secondary consequence."). See also *Alappat*, 33 F.3d at 1543, 31 USPQ2d at 1556-57 (quoting *Diamond v. Diehr*, 450 U.S. at 192, 209 USPQ at 10). See also *id.* at 1569, 31 USPQ2d at 1578-79 (Newman, J., concurring) ("unpatentability of the principle does not defeat patentability of its practical applications") (citing *O'Reilly v. Morse*, 56 U.S. (15 How.) at 114-19). If a physical transformation occurs outside the computer, a disclosure that permits a skilled artisan to practice the claimed invention, i.e., to put it to a practical use, is sufficient. On the other hand, it is necessary for the claimed invention taken as a whole to produce a practical application if there is only a transformation of signals or data inside a computer or if a process merely manipulates concepts or converts one set of numbers into another.

A claimed process is clearly statutory if it results in a physical transformation outside the computer, i.e., falls into one or both of the following specific categories ("safe harbors").

MPEP 2106(IV)(B)(2)(b)(ii):

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For such subject matter to be statutory, the claimed process must be limited to a practical application of the abstract idea or mathematical algorithm in the technological arts. See *Alappat*, 33 F.3d at 1543, 31 USPQ2d at 1556-57 (quoting *Diamond v. Diehr*, 450 U.S. at 192, 209 USPQ at 10). See also *Alappat* 33 F.3d at 1569, 31 USPQ2d at 1578-79 (Newman, J., concurring) ("unpatentability of the principle does not defeat patentability of its practical applications") (citing *O'Reilly v. Morse*, 56 U.S. (15 How.) at 114-19). A claim is limited to a practical application when the method, as claimed, produces a concrete, tangible and useful result; i.e., the method recites a step or act of producing something that is concrete, tangible and useful. See *AT & T*, 172 F.3d at 1358, 50 USPQ2d at 1452. Likewise, a machine claim is statutory when the machine, as claimed, produces a concrete, tangible and useful result (as in *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601) and/or when a specific machine is being claimed (as in *Alappat*, 33 F.3d at 1544, 31 USPQ2d at 1557 (\**en banc*)). For example, a computer process that simply calculates a mathematical algorithm that models noise is nonstatutory. However, a claimed process for digitally filtering noise employing the mathematical algorithm is statutory.

**MPEP 2106(IV)(B)(2)(a):**

A machine is "a concrete thing, consisting of parts or of certain devices and combinations of devices." *Burr v. Duryee*, 68 U.S. (1 Wall.) 531, 570 (1863).

If a claim defines a useful machine or manufacture by identifying the physical structure of the machine or manufacture in terms of its hardware or hardware and software combination, it defines a statutory product. See, e.g., *Lowry*, 32 F.3d at 1583, 32 USPQ2d at 1034-35; *Warmerdam*, 33 F.3d at 1361-62, 31 USPQ2d at 1760. Office personnel must treat each claim as a whole. The mere fact that a hardware element is recited in a claim does not necessarily limit the claim to a specific machine or manufacture. Cf. *In re Iwahashi*, 888 F.2d 1370, 1374-75, 12 USPQ2d 1908, 1911-12 (Fed. Cir. 1989), cited with approval in *Alappat*, 33 F.3d at 1544 n.24, 31 USPQ2d at 1558 n.24.

Claims 24-29, 63, 64 and 68-73, especially claims 24, 63 and 68, do not produce a useful and tangible result as set forth in MPEP 2106 (IV)(B)(2)(b) and 2106(IV)(B)(2)(b)(ii), e.g., a created ENTERPRISE JAVABEAN or an obtained security realm are not useful and tangible results. Therefore, claims 24 and 63 are non-statutory.

Regarding claim 68, instead of defining a system by identifying the physical structure of the system in term of its hardware or hardware and software combination, the system of claim 76 directs to software *per se*. Therefore, claim 76 is non-statutory.

**Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 24-29, 63, 64 and 68-73 are rejected under 35 U.S.C. 102(e) as anticipated by Singer et al. [USP 6,557,009 B1] and Monson-Haefel [Enterprise JavaBeans, 2<sup>nd</sup> Edition] or, in the alternative, under 35 U.S.C. 103(a) as obvious over Singer et al. [USP 6,557,009 B1] in view of Monson-Haefel [Enterprise JavaBeans, 2<sup>nd</sup> Edition].**

Regarding claims 24, 63 and 68, Singer teaches *a method, program and system for generating a unified user profile for providing transparent access to a personalization database and external user database* (As in FIG. 3Ci, *a unified user profile* is created for providing transparent access to *a personalization database*, e.g., permit database 18 of FIG. 1, and *external user database*, e.g., the database as illustrated at Col. 8, Lines 30-41 controlled by e-payment system 20 of FIG. 1). The Singer method comprises the step of:

*obtaining a base user JAVABEAN adapted to work through a personalization server to access said personalization database through a personalization server, wherein said base user JAVABEAN is adapted to provide a transparent interface to a user or application through which implicit and explicit properties can be retrieved and updated from the personalization database* (Enterprise Java Beans as a base user JAVABEAN is used to implemented the access method (Singer, Col. 5, Line 66-Col. 6, Line 4). As in FIG. 1, Application



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Sever 16 is a *personalization server*. Permit Database 18 is *personalization database* or *first database*. FIG.

3Civ is a *transparent interface to a user*, wherein *implicit properties*, e.g., a property without an asterisk, and *explicit properties*, e.g., a property with an asterisk, are retrieved and updated as disclosed at Col. 6, Lines 55-57);

*wherein the access is carried out independent of any knowledge of the user or application of the naming convention of the data in the database* (This feature is an inherited feature of ENTERPRISE JAVABEAN as disclosed by Monson-Haefel (Monson-Haefel, page 90, Set and Get Methods), and

*wherein implicit and explicit properties comprise getter and setter properties* (Monson-Haefel, page 90, Set and Get Methods).

*transparently retrieving and updating said implicit and explicit properties from an external user database* (Singer, FIG. 3G, *implicit properties*, e.g., a property without an asterisk, and *explicit properties*, e.g., a property with an asterisk, are retrieved and updated from *external user database*, or *second database*; e.g., the database as illustrated at Col. 8, Lines 30-41 controlled by e-payment system 20 of FIG. 1, as disclosed at Col. 8, Lines 37-43);

*obtaining a security realm adapted to allow authentication of data in said personalization database and said external user database* (Singer, Col. 6, Lines 26-53).

The missing of Singer is claimed limitation *creating an ENTERPRISE JAVABEAN to extend the base user JAVABEAN* to access the database controlled by e-payment system 20, wherein *the extended base user java bean utilizes a property set* in order to give *namespace qualifications* to implicit and explicit properties of said data in said personalization database.

As disclosed by Monson-Haefel, session beans of ENTERPRISE JAVABEAN are an extension of the client application for managing processes or tasks (Monson-Haefel, page 20). A session bean utilizes a property set in order to give namespace qualifications to implicit and explicit properties of data in the database (Monson-Haefel, page 80 and page 84, e.g., `sd.setEnterpriseBeanClassName ()`, `sd.setHomeInterfaceClassName()...`). Thus, in order to

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*retrieve and update said implicit and explicit properties from an external user database, a session bean as an ENTERPRISE JAVABEAN to extend the base user JAVABEAN is implied in Singer technique.*

Regarding claims 24, 63 and 68, Singer teaches *a method, program and system for generating a unified user profile for providing transparent access to a personalization database and external user database* (As in FIG. 3Ci, *a unified user profile* is created for providing transparent access to *a personalization database*, e.g., permit database 18 of FIG. 1, and *external user database*, e.g., the database as illustrated at Col. 8, Lines 30-41 controlled by e-payment system 20 of FIG. 1). The Singer method comprises the step of:

*obtaining a base user JAVABEAN adapted to work through a personalization server to access said personalization database through a personalization server, wherein said base user JAVABEAN is adapted to provide a transparent interface to a user or application through which implicit and explicit properties can be retrieved and updated from the personalization database* (Enterprise Java Beans as a base user JAVABEAN is used to implement the access method (Singer, Col. 5, Line 66-Col. 6, Line 4). As in FIG. 1, Application Server 16 is *a personalization server*. Permit Database 18 is *personalization database or first database*. FIG. 3Civ is *a transparent interface to a user*, wherein *implicit properties*, e.g., a property without an asterisk, and *explicit properties*, e.g., a property with an asterisk, are retrieved and updated as disclosed at Col. 6, Lines 55-57);

*wherein the access is carried out independent of any knowledge of the user or application of the naming convention of the data in the database* (This feature is an inherited feature of ENTERPRISE JAVABEAN as disclosed by Monson-Haefel (Monson-Haefel, page 90, Set and Get Methods), and

*wherein implicit and explicit properties comprise getter and setter properties* (Monson-Haefel, page 90, Set and Get Methods).

*transparently retrieving and updating said implicit and explicit properties from an external user database* (Singer, FIG. 3G, *implicit properties*, e.g., a property without an asterisk, and *explicit properties*, e.g., a

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property with an asterisk, are retrieved and updated from *external user database*, or *second database*, e.g., the database as illustrated at Col. 8, Lines 30-41 controlled by e-payment system 20 of FIG. 1, as disclosed at Col. 8, Lines 37-43);

*obtaining a security realm adapted to allow authentication of data in said personalization database and said external user database* (Singer, Col. 6, Lines 26-53).

The missing of Singer is claimed limitation *creating an ENTERPRISE JAVABEAN to extend the base user JAVABEAN* to access the database controlled by e-payment system 20, wherein *the extended base user java bean utilizes a property set* in order to give namespace qualifications to implicit and explicit properties of said data in said personalization database.

As disclosed by Monson-Haefel, session beans of ENTERPRISE JAVABEAN are an extension of the client application for managing processes or tasks (Monson-Haefel, page 20). A session bean utilizes a property set in order to give namespace qualifications to implicit and explicit properties of said data in the database (Monson-Haefel, page 80 and page 84, e.g., `sd.setEnterpriseBeanClassName()`, `sd.setHomeInterfaceClassName()`...).

It would have been obvious for one of ordinary skill in the art at the time the invention was made to create a session bean or ENTERPRISE JAVABEANS in order to manipulate the database controlled by e-payment.

Regarding claims 25, 64 and 69, Singer and Monson-Haefel, in combination, teach all of the claimed subject matter as discussed above with respect to claims 24, 63 and 68, Singer further discloses the step of *generating transparent read and write access to said external database* (Singer, Col. 8, Lines 37-62). Monson-Haefel teaches session bean as *extended said base user java bean* as discussed above with respect to claims 24, 63 and 68. It would have been obvious for one of ordinary skill in the art at the time the invention was made to combine the method of creating

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ETERPISE JAVABEANS as taught by Monson-Haefel into Singer method as suggested in order to create Web Application as disclosed by Singer as in FIG. 3G.

Regarding claims 26 and 70, Singer and Monson-Haefel, in combination, teach all of the claimed subject matter as discussed above with respect to claims 24 and 68, Singer further discloses the step of *configuring a server to provide said read and write access* (Singer, Col. 6, Lines 18-25).

Regarding claims 27 and 71, Singer and Timbol, in combination, teach all of the claimed subject matter as discussed above with respect to claims 26 and 68, Singer further discloses *server is a personalization server* (Singer, FIG. 1, Col. 6, Lines 18-25).

Regarding claims 28 and 72, Singer and Monson-Haefel, in combination, teach all of the claimed subject matter as discussed above with respect to claims 24 and 68, Singer further discloses *external user database is selected from the group consisting of legacy databases, corporate databases, and customer databases* (Singer, Col. 8, Lines 33-62).

Regarding claims 29 and 73, Singer and Monson-Haefel, in combination, teach all of the claimed subject matter as discussed above with respect to claims 24 and 68, Singer further discloses *external user database contains data selected from the group consisting of authentication information, user lists, group lists, and group membership* (Singer, Col. 8, Lines 33-62).

**Conclusion**

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

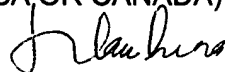
Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUNG Q. PHAM whose telephone number is 571-272-4040. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, TIM T. VO can be reached on 571-272-3642. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you

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would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



HUNG Q PHAM

Examiner

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September 21, 2006



TIM VO  
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